

REMARKS

Claims 1, 5-11, and 20-34 are pending in the present application. Claims 8-10, 22-23, and 25-34 have been withdrawn, and claims 1, 5-7, 11, 20, 21, and 24 are pending for consideration according to the examiner. No claims have been amended in this paper.

CLAIMS 25-30 IMPROPERLY WITHDRAWN

On page 2, first paragraph of the current final Office action, the examiner withdrew claims 25-30 from consideration “as being drawn to non-elected species.” Applicant believes this to be in error. In response to the restriction requirement of December 19, 2005, applicant elected to prosecute claims 25-30 (see page 6, Response to Election of Species, filed on January 16, 2006, “Applicant believes claims 1, 5-11, 20, 21, 22-31, and 33 are readable on Species 6” shown in Figs. 9 and 10). Applicant believes claims 25-30 read on the elected Species 6, since Fig. 9 shows a filament wrapped around a stent. The examiner further withdrew claims 8-10, 22, 23, and 31-34 in the Non-final Office Action mailed February 3, 2006. Claims 25-30 were not withdrawn by the examiner in the Non-final Office Action. Based on the foregoing procedural reason, applicant respectfully requests that claims 25-30 be reinstated for consideration.

ANTECEDENT SUPPORT IN SPECIFICATION FOR CLAIM 25

The examiner objected to the specification for not providing antecedent basis for the subject matter of claim 25. Applicant respectfully maintains that as to claim 25 reciting a filament be wrapped around and heat bonded to the stent “such that it does not overlie the distal end and the proximal end of the stent,” applicant can rely on the teachings of Fig. 9 since the drawing clearly depicts this limitation.

The examiner on page 3 of the Office action states that applicant has no basis to support its assertion that “[i]t follows then that the *sheath or filament* in this embodiment

is shorter than the length of the stent ...” (italics added, page 10, Response to Non-Final Office Action Mailed February 3, 2006, filed June 26, 2006). Applicant respectfully disagrees based on the following.

The specification teaches that the sheath may be longitudinally shorter than the length of the stent (page 10, lines 4-5, specification). Filament 70 shown in Fig. 9 is an alternative embodiment to the sheath of Fig. 1 (page 12, lines 26-29, specification). “*As with the sheaths 16 described previously with respect to FIGS. 1-8, the filament 70 of FIG. 9 ...*” (italics added, page 13, lines 9-10, specification), implying that the sheath 16 and the filament 70 are interchangeable. Since applicant’s specification describes sheaths and filaments as interchangeable alternative embodiments, a person skilled in the art would reasonably conclude that the *sheath or filament* is shorter than the length of the stent with respect to Fig. 9. Applicant’s statement regarding “sheath or filament ...” is indeed supported by the specification.

PRIORITY DATE OF CLAIMS 25-30 SHOULD BE JUNE 29, 2001

The examiner on page 3 of the final Office action states that “Claims 25-30 receive priority benefit of parent application 09/897,743 and have an effective filing date of June 29, 2001.” On page 4 of the final Office action, the examiner states the contrary: “However with respect to claim 25, examiner disagrees with applicant’s arguments and conclusions regarding the claimed feature; and the effective priority date for claims 25-30 would be applicant’s filing date of this application.”

Applicant respectfully asserts that claims 25-30 date back to June 29, 2001, the filing date of the parent application. The support in the specification for claim 25 is found in the section immediately above, captioned “ANTECEDENT SUPPORT IN SPECIFICATION FOR CLAIM 25.” Since the specification dates back to June 29, 2001, so do claims 25-30.

PRIOR ART REJECTIONS

The examiner continues to reject claims 1, 5, 6, 11 and 24 under 35 U.S.C. § 102(e) over Lenker `161. This rejection is respectfully traversed.

The examiner on page 4 of the final Office action appears to agree that claims 1, 5, 6, 11, and 24 have a priority date back to June 29, 2001. This is prior to the April 25, 2002 filing date of the Lenker `161 reference. Lenker `161 is therefore not prior art to claims 1, 5, 6, 11, and 24.

The examiner then asserts that the teachings of Lenker `161 can be traced back to its great grandparent patent (U.S. Patent No. 5,843,158 (Lenker)) and should be afforded the Lenker `158 filing date. Applicant respectfully disagrees.

Lenker `161 is a continuation-in-part patent, and the teachings in Lenker `161 relied upon by the examiner for the rejection cannot be found in the great grandparent Lenker `158. Dating the teachings of Lenker `161 back to the early priority date of Lenker `158 is therefore improper. Applicant demonstrates this point in the following.

First, the rejection relies on Figs. 1A, 1B, 2A, 2B, 2C of Lenker `161. However, the drawings labeled Figs. 1A, 1B, 2A, 2B, 2C and the five figure numbers of Lenker `161 do not appear anywhere in the earlier Lenker `158. Since the later Lenker `161 is a CIP and a great grandchild of Lenker `158, it is highly likely that Figs. 1A, 1B, 2A, 2B, 2C the examiner is relying on are new matter added in the CIP Lenker `161, which teachings should not date back to Lenker `158.

Second, if the examiner is relying on the early priority date and teachings of Lenker `158, the examiner should then not frame the rejection based on Lenker `161, but should make the rejection based on Lenker `158. More importantly, the examiner has not cited to any specific passages in Lenker `158 to support the rejection.

Third, the examiner relies on Lenker `161 which subject matter according to the examiner is “fully disclosed” in the earlier Lenker `158. In order to support a novelty rejection of independent claim 1, Lenker `158 must teach each element of claim 1. On page 4 of the Office action, the examiner references six full columns of text (columns 4, 5, 7, 9, 12, and 14) in Lenker `158 which purportedly support the novelty rejection.

Applicant respectfully contends that this rejection is improper on its face since it does not identify specifically where the teachings of each claim element are in Lenker `158. 37 C.F.R. § 1.104(c)(2) (“When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable.”) The burden is left up to applicant to hunt for support for the examiner’s rejection, and applicant has done this below.

Lenker `158 is directed to a graft that includes a self-expanding support frame or rings and an inner liner made from a fabric; the liner may also be woven into the frame or rings. Applicant has read through all six full columns of text in Lenker `158 cited by the examiner and has summarized briefly each column in the following.

Column 4: Invention is a stent/frame 72 with a liner 92 on the inside of the stent/frame (see Figs. 5 and 5A of Lenker `158).

Column 5: Inner liner material may be made of yarns, and methods of deploying the prosthesis.

Column 7: Discusses ring frames 14 of stent/liner of Fig. 1, and delivery catheter structure and use thereof in Fig. 2.

Column 9: Discusses frame limited expansion of Fig. 5 embodiment with an inner liner 92, stent frame rings 72, and a frame belt 94. Frangible elements fail in tension when the prosthesis is under a predetermined expansion threshold load. (Applicant notes that there is no teaching or suggestion of “wherein the biocompatible material is configured to fail at

an inflation pressure below the nominal inflation pressure of the expandable member” from claim 1.)

Column 12: Graft 120 of continuously woven fibers with fill fibers 122 and warp fibers 124 of yarn; yarn heating and fabrication for controlled expansion.

Column 14: Alternative embodiments of fill fibers, sealing cuffs 76 of Figs. 3 and 4; braided cuff 168 with ring frame integrated into liner 162, shown in Fig. 11A.

In view of the foregoing, applicant did not find support for the examiner’s novelty rejection in the enumerated columns of Lenker `158. Applicant maintains that the teachings of Lenker `161 that the examiner relies upon (1) have no support in Lenker `158 and do not date back to the great grandparent; and (2) was new matter introduced when Lenker `161 was filed in April 25, 2002.

Since the teachings of Lenker `161 relied upon by the examiner for the rejection do not date back to Lenker `158, and since Lenker `161 is not prior art, this rejection is unsupported and should be withdrawn.

The examiner rejected claim 7 under 35 U.S.C. § 103(a) over Lenker `161 in view of Lenker `158. This rejection is respectfully traversed.

Applicant relies on the argument propounded in its June 26, 2006 response, establishing that claim 7 dates back to at least June 29, 2001, the filing date of the parent patent. The Lenker `161 reference, which has a filing date of April 25, 2002, is not prior art to claim 7. Since Lenker `161 is not prior art, it must be withdrawn, and this 103 obviousness rejection is no longer supportable without it and should be withdrawn.

The examiner rejected claims 20 and 21 under 35 U.S.C. § 103(a) over Lenker `161 in view of Lenker et al. `158 and Solar `635. This rejection is respectfully traversed.

Applicant again relies on the argument propounded in its response filed June 26, 2006 establishing that Lenker `161 is not prior art to claims 20 and 21. Accordingly, if Lenker `161 is no longer prior art to claims 20 and 21, the obviousness rejection is unsupportable and should be withdrawn.

The examiner rejected claims 27 and 28 under 35 U.S.C. § 103(a) over Lenker `158 in view of and Solar `635. This rejection is respectfully traversed.

The examiner withdrew claims 25-30 from consideration in the current Office action (see page 2). Applicant respectfully contends that the withdrawal was improper and requests that claims 25-20 be reinstated for consideration. Assuming these claims are reinstated, applicant has the following response to the rejection.

Neither Lenker nor Solar teaches a biocompatible material comprising a filament that is wrapped around and heat bonded to the stent wherein the heat bond fails during expansion of the stent as recited in independent claim 25. Independent claim 25 and dependent claims 27 and 28 are therefore patentable over the cited references individually or in combination.

Moreover, independent claim 25 provides that “the biocompatible material comprises a filament . . . such that it does not overlie the distal end and the proximal end of the stent.” In the Solar reference in Figs. 4a and 4c, and at column 6, lines 50 - 58, the teaching is clear that the retaining sheaths 40 are extended over the ends of the stent 10. Therefore, even if Lenker `158 and Solar were properly combinable, the combination does not teach that the biocompatible material does not overlie the distal end and the proximal end of the stent, as recited in claim 25.

In fact, the Solar reference teaches away from the claimed invention since the distal and proximal ends of the stent are covered by the retaining sheath/biocompatible material 40 as plainly seen in Figs. 4a and 4c of Solar. At least for these reasons, claims

25, 27, and 28 are not obvious in view of Lenker '158 and Solar individually or in combination.

In view of the foregoing, all claims are now in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested and allowance at an early date is solicited. The Commissioner is authorized to charge deposit account no. 06-2426 for any unforeseen fees arising in connection with the filing of this paper.

Respectfully submitted,
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